REMARKS

Claims 1-17 are pending in the above-referenced patent application.

Claims 1-4 and 9-17 have been rejected.

Claims 5-8 have been objected to

No claims have been allowed.

No claims have been amended in this Response.

Claims 1-17 remain in this Application.

Reconsideration of the claims of this Application is respectfully requested.

Allowable Subject Matter

The Applicant thanks the Examiner for the indication in section 5 of the Office Action that Claims 5-8 would be allowable if rewritten in independent form. However, because the Applicant believes that Claims 5-8 depend from an allowable base claim, as described below, the Applicant has not rewritten Claims 5-8 in independent form.

35 U.S.C. § 103(a) Obviousness

In section 7 of the Office Action, the Examiner rejected Claims 1-3, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,337,619 to *Kowalski et al.* (hereinafter "*Kowalski*") in view of U.S. Patent Application No. 2002/0175705 A9 to *Armstrong et al.* (hereinafter "*Armstrong*"). In section 8 of the Office Action, the Examiner rejected Claims 4 and

14-16 under 35 U.S.C. § 103(a) as being unpatentable over *Kowalski* and *Armstrong* in further view of U.S. Patent No. 6,133,832 to *Winder et al.* (hereinafter "*Winder*"). In section 9 of the Office Action, the Examiner rejected Claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Armstrong* in view of U.S. Patent No. Patent No. 5,838,226 to *Houggy et al.* (hereinafter "*Houggy*"). In section 10 of the Office Action, the Examiner rejected Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Armstrong* and *Houggy* in further view of U.S. Patent Application No. 2002/0084890 A1 to *Guerrieri et al.* (Hereinafter "*Guerrieri*"). In section 11 of the Office Action, the Examiner rejected Claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Kowalski* and *Armstrong* in further view of *Guerrieri*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to

grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With regard to independent Claims 1 and 12, the Examiner acknowledges that the method taught in *Kowalski* lacks the step of sending an address inquiry signal to a specific address, as recited in independent Claims 1 and 12. The Applicant agrees that *Kowalski* fails to teach the recited limitation. However, the Examiner then asserts that "the common knowledge of controllers transmitting interrogation signals addressed to specific transponders is taken to be admitted prior art since the Applicant failed to traverse the examiner's assertion of official notice in the previous Office Action." The Applicant traverses this assertion.

The Examiner's actual statement in the previous Office Action was, "Though Kowalski's method lacks the step of sending an interrogation signal or address inquiry signal to determine the presence of modules having a specific address, the Examiner takes Official Notice that controllers with the ability to determine whether a specifically addressed transponder is present are well known." *Office Action mailed December 10, 2003, page 6, lines 5-8.* In the Applicant's response to the previous Office Action, the Applicant stated, "The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response." *Applicant's Response to Office Action mailed December 10, 2003, page 20, last two lines.* Thus, the Applicant properly traversed the Examiner's assertion of Official Notice.

The Applicant respectfully submits that the assertions made in the Official Notice are not "capable of instant and unquestionable demonstration as being well-known" as required by M.P.E.P. § 2144.03. The Applicant respectfully requests that the Patent Office provide documentary evidence showing that controllers with the ability to determine whether a specifically addressed transponder is present are actually "well known in the art" as asserted in the Office Action.

The Examiner further asserts that *Armstrong* describes "host computer 100 or controller transmitting a Read Tag_ID command to transponders 150 and determining from the received Tag_IDs if there is a transponder 150 that has the same Tag_ID or address as another transponder 150," citing *Armstrong*, Section [0062], lines 11-26. The cited passage, in relevant part, states:

> As demonstrated above, once generated, this random number-based Tag_ID is communicated to host computer 100 during a Read Tag_ID process, and thereafter permits host 100 to subsequently address only that specific transponder using the

> associated Tag_ID. If, in the course of time, an article arrives having a transponder 150 possessing the same Tag_ID as another transponder 150 currently within the population of transponders 150, host computer 100 can cause groups or individual transponders 150 to select a new Tag_ID.

The Applicant respectfully submits that the cited passage does not teach "receiving back a response to the address inquiry signal from the first device, [and] determining whether one or more additional responses to the address inquiry signal are received from one or more of the other devices in the neighborhood group" as recited in independent Claims 1 and 12.

Thus, the *Kowalski* and *Armstrong* references, either alone or in combination, do not disclose, suggest or hint at all the claim limitations of independent Claims 1 and 12. Furthermore, the Applicant respectfully submits that the *Winder*, *Houggy* and *Guerrieri* references do not overcome this shortcoming of the *Kowalski* and *Armstrong* references. Claims 2-4 and 9-17 depend, directly or indirectly, from Claims 1 and 12, and contain their respective limitations.

Moreover, even assuming (without admitting) that the *Armstrong* reference describes the Applicant's claimed limitations, the Applicant respectfully submits that there is neither motivation or suggestion to modify the method of *Kowalski* as taught by *Armstrong* to cause modules to generate random addresses upon detection of duplicate addresses, as asserted by the Examiner.

The *Kowalski* reference teaches a method of establishing communication between a terminal and one of a plurality of modules. In all variations of the *Kowalski* method, the only technique used to select among multiple responding modules is the choice by each module of a random time interval to delay before responding to a general interrogation signal. The terminal then selects the first-

responding module and all other modules are thereby deselected. In both Figures 4 and 5, it can be seen that when two modules respond together to a first general interrogation signal, a second general interrogation signal is sent out and the same technique is used again to choose between the two modules. Should the system of *Kowalski* somehow be modified to detect the situation of two modules have the same address, the Examiner has failed to provide the motivation for a person of ordinary skill in the art to abandon technique used in all other such situations in *Kowalski* and apply techniques purportedly found in the *Armstrong* reference.

Rather than departing from the successful technique of the *Kowalski* reference, the Applicant submits that the person of ordinary skill in the art would reapply the technique and choose among modules with the same address by sending an interrogation signal to their common address, selecting the first-responding module. As such, the Applicant respectfully asserts that the Examiner has inappropriately applied hindsight when combining the teachings of the *Kowalski* reference and the *Armstrong* reference in order to arrive at the claimed invention recited in independent Claims 1 and 12. The teaching to modify *Kowalski* by causing modules to generate random addresses upon detection of duplicate addresses comes from the Applicant's patent application, rather than from the references themselves or the knowledge generally available to one of ordinary skill in the art.

For all the above reasons, a *prima facie* case of obviousness has not been established and the Applicant respectfully requests that the rejection of Claims 1-4 and 9-17 under § 103 be withdrawn and that Claims 1-4 and 9-17 be passed to allowance.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

Conclusion

As a result of the foregoing, the Applicant asserts that the claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

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SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Aug. 18, 2004

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